

## Trial decision

Revocation No. 2013-300942

Chiba, Japan

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The case of trial regarding the revocation of the Trademark Registration No. 1859812 between the parties above has resulted in the following trial decision.

### Conclusion

The Trademark Registration No. 1859812 is cancelled.

The costs in connection with the trial shall be borne by the demandee.

### Reason

#### No. 1 The Trademark

The trademark with Trademark Registration No. 1859812 (referred to as "the Trademark" below) consists of Alphabetic characters of "Line" and katakana of "ライン(line)" horizontally written in two lines. The application for its registration was filed on April 1, 1983, and the trademark was registered on May 30, 1986 with designated goods of Class No. 4 which are as specified in the Trademark Registry. After that, the designated goods' reclassification was registered to set the designated goods to "Soaps and detergents; Dentifrices; Cosmetics and toiletries; Natural perfumery prepared from vegetables, Natural perfumery prepared from animals, Synthetic perfumery, Compound perfumery, Food flavorings prepared from essential oils; Incenses and fragrance." of

Class No. 3 on August 9, 2006.

The request for the trial was registered on November 21, 2013.

## No. 2 The demandant's allegation

The demandant requested a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for request in the written request for trial, the written refutation of a trial case, and the oral proceedings statement brief as follows, and submitted Evidence A No. 1 to A No. 6 (including their branch numbers) as means of evidence.

### 1 Statement of the demand

Regarding the Trademark, there had been no fact that any of the holder of trademark right, and its exclusive licensee or non-exclusive licensee has used the registered trademark in Japan in connection with the designated goods concerned for three consecutive years or longer. Therefore, the registration of the Trademark should be invalidated in accordance with Article 50(1) of the Trademark Act.

### 2 Reasons for rebuttal

The Trademark is a trademark having the characters of "Line" (Note: description of "LINE" in the written refutation of a trial case is wrong) and "ライン(line)" written in two lines. However, in the documents submitted by the demandee, five lines including other descriptions such as "Rubotan", "LIQUID", "ルボタン(rubotan)" are written on the principal surface of the product, and a single line of "ルボタン ライン(rubotan line)" is written on the rear surface of the product without the description of "LINE", and "ルボタン ライン(rubotan line)" is not written in two lines. Therefore, it is obvious that the Trademark itself is not used.

#### (1) Description on principal surface of product

On the principal surface of the product, "Rubotan/LINE" is displayed on the upper side and "ルボタン/ライン(rubotan/line)" is displayed on the lower side, of the description of "LIQUID" which displays the quality indicating that the product is liquid (Evidence B No. 1-1). With this configuration, the five lines are divided into the upper part and the lower part which sandwich "LIQUID" therebetween. It should be recognized that the trademark having the pronunciation of "rubotanrain" is written with the Alphabetic characters in the upper part and with katakana in the lower part.

According to the above, it cannot be recognized that "LINE" and "ライン(line)" are independently displayed on the principal surface of the product.

As confirming this, on the rear surface of the product, "ルボタン ライン

(rubotan line)" is written in a single uppermost line with a character size larger than other characters, and the characters of "ルボタン(rubotan)" and "ライン(line)" have the same size. This intends to read the characters of "ルボタン(rubotan)" and "ライン(line)" in one breath, and does not intend to read "ルボタン(rubotan)" and "ライン(line)" independently (Evidence B No. 1-2). The display confirms that the trademark used for the product is a mark having the pronunciation of "rubotanrain" and makes traders and consumers read it as "rubotanrain".

Furthermore, in the cosmetics industry, there have been many examples in which the company name is used as a product name and the company name is applied to the registered trademark (Evidence A No. 1 and A No. 2). Accordingly, regarding an eyeliner which is a cosmetic product, it is natural to recognize the trademark including the company name as a single trademark. Therefore, "ルボタン(rubotan)" coincides with the company name of "Rubotan Corporation" (referred to as "Rubotan company" below) which is a group member of the demandee (Evidence B No. 4), and it can be considered that the trademark has a configuration of a mark according to the practices of the cosmetics industry. Accordingly, from this point, it cannot be said that the character part of "ライン(line)" has distinctiveness as an independent part from the characters of "ルボタン(rubotan)".

In addition, the name (trademark) of the cosmetic products manufactured by Rubotan company can be recognized in the advertisement on Internet (Evidence A No. 3). In the cosmetic products, there is a product having the characters of "ルボタン(rubotan)" positioned at the center of the product name and obviously forming a part of the trademark of the product.

According to this fact, Rubotan company and other companies similarly have practices such that the characters of "ルボタン(rubotan)" are intentionally included in the product name (trademark). In a case of the product of the case, the characters of "ルボタン(rubotan)" are included in the product name (trademark).

Then, the characters of "ルボタン(rubotan)" included in the name of the product (trademark) of the case should form a single trademark together with the characters of "ライン(line)", and traders and consumers are made to read in the same way. It can be said that both characters form single distinctiveness in the business transactions when being integrally used. Therefore, it cannot be said that only the character part of "ライン(line)" has independent distinctiveness in the business transactions.

The demandee emphasizes that the paragraph is divided as a basis of "Alphabetic characters of "LINE" and katakana of "ライン(line)" are displayed in a

configuration and mode in which "LINE" and "ライン(line)" have independent distinctiveness". However, the description on the principal surface of the product was made in a mode such that the central lines of the characters coincides with each other, and the upper and lower parts give corrective impression as a whole. Therefore, based on only the fact that the paragraph is divided, it cannot be simply assumed that each part has a configuration and a mode independently having distinctiveness in a scene of the actual business transactions. Actually, the trademark registered by the demandee is written in two lines, and a single trademark is written in two lines. Therefore, it is normal that traders and consumers recognize the trademark written in two lines as an integrated trademark.

In consideration of the above points, in the description on the product of the case, each of "Rubotan/LINE" and "ルボタン/ライン(rubotan/line)" form a single trademark.

Accordingly, it cannot be considered that the part of "LINE" and the part of "ライン(line)" are formal use of the registered trademark by independently recognizing only the part of "LINE" and the part of "ライン(line)" in the five-line configuration written on the principal surface of the product, as ignoring the actual condition of the business transactions.

As described above, it cannot be said that the trademark identical to the Trademark from generally accepted perspective was used on the grounds of the description on the principal surface of the product.

## (2) Description on rear surface of product

It is not certain whether the demandee mentions the description on the rear surface of the product as the grounds of the use of the Trademark. However, if the demandee mentions the above, as in (1) described above, the description of "ルボタンライン(rubotan line)" on the rear surface of the product should be recognized as a single trademark. Therefore, it cannot be said that the trademark identical to the Trademark from generally accepted perspective was used on the grounds of the description on the rear surface of the product.

## 3 Allegation in the oral proceedings statement brief

### (1) Supplemental reasons in written refutation

A On July 17, 2014, in a shop of "MASUDAMASU CO.,LTD. (referred to as "MASUDAMASU" below)" which is indicated as a customer in Evidence B No. 2 by the demandee, when a people involved in the attorney asked about "ライン(line)" which is the product of the eyeliner, a shop clerk was not able to identify the product. Then, when an image of the product is shown, the shop clerk said that "We have ルボタ

ン(rubotan)" and could identify the product (Evidence A No. 4 and A No. 5).

In addition, on the same day, the person involved in the attorney called "Shinsekai Beniya" which is indicated as a customer in Evidence B No. 3 by the demandee and confirmed whether the eyeliner product "ライン(line)" are in stock. The shop responded as "Only ライン(line) does not indicate any company" and "eyelines are called as "line"". Then, the person mentioned the product of "ルボタンライン(rubotan line)", the shop responded as "We have rubotan" (Evidence A No. 6).

These facts indicate that, in a case where traders and consumers are assumed as a reference, the part of "ライン(line)" separated from the whole configuration does not have distinctiveness, and the part of "ライン(line)" can be identified only by being combined with the part of "ルボタン(rubotan)".

B In a space of the product name in the sales slips (Evidence B No. 2 and B No. 3), "rubotan lain" is written. On the other hand, there is no document in which "ライン(line)" is written without being combined with "ルボタン(rubotan)". Therefore, traders and consumers recognize the product as "ルボタン ライン(rubotan line)", not "ライン(line)".

C As described above, the trademark which is used for the product of the demandee is "ルボタン ライン(rubotan line)" and is not identical to the Trademark from generally accepted perspective.

## (2) Opinion on the oral proceedings statement brief by demandee

### A Regarding product's photos of Evidence B No. 1

To prove the manufactured time of the product, that is, the time when the trademark is applied based on the descriptions of "A33", "A25", and "A37" in labels of the rear surfaces in the product's photos, the demandee submitted a lot number display rule (Evidence B No. 8) as the description on the meaning of each character described above. However, the rule is a standard in the demandee, in addition, the lot number is not mechanically and automatically selected. Therefore, the lot number can be artificially changed. According to this point, only the descriptions displayed in the labels and the existence of Evidence B No. 8 and B No. 9 do not specify the manufactured time of the product, that is, the time when the trademark is applied.

### B Regarding sales slips in Evidence B No. 2 and B No. 3

As grounds for that the product with the name of "ルボタン ライン(rubotan line)" in Evidence B No. 2 and B No. 3 is identical to the product in Evidence B No. 1, the demandee indicates Evidence B No. 5 to B No. 8. However, since the label on the rear surface of the product in Evidence B No. 1 and B No. 5 to B No. 7 can be

exchanged, even if the label itself is identical to that on the product of "ルボタン ライン(rubotan line)" in Evidence B No. 2 and B No. 3, it cannot be said that the products are identical to each other.

Based on the grounds indicated in Evidence B No. 1 and B No. 5 to B No. 7, not only the product to be transferred, but also the manufactured time thereof cannot be specified. In addition, regarding the bar codes in Evidence B No. 5 to B No. 7, if the product name and the content component are not changed, even when the style of the characters on the surface of the product is changed, there is a case where the same bar code is used. Therefore, according to the fact such that the bar codes are identical to each other, regardless of that the description on the surface of the product is the same as that in Evidence B No. 1, it cannot be said that the products are identical to each other.

Therefore, according to Evidence B No. 2 and B No. 3 (sales slips), it cannot be said that the product identical to the product in Evidence B No. 1 has been sold, and it cannot be said that the sales of the product having the description identical to that of the product in Evidence B No. 1 has been proved.

C Regarding company profile in Evidence B No. 4 and Article 2(3) of the Trademark Act

It is assumed that implicit establishment of the rights of non-exclusive use be acknowledged under law. If the rights of non-exclusive use are implicitly established, an action based on the establishment of the right such as payment of royalty and the like should be made. Even though these circumstances have not been confirmed, the establishment of the implicit rights of non-exclusive use should not be acknowledged only based on the point that the company is a member of the group.

Therefore, it cannot be said that the sales by Elizabeth Corporation (referred to as "Elizabeth" below) has proved the sales by the non-exclusive licensee. Furthermore, regarding the point indicating the sales by the demandee to Elizabeth, there is no document that directly proves the above sales, and even if the fact of the sales can be recognized, the sold time is not clear.

Regarding the grounds in Evidence B No. 1 and B No. 5 to B No. 7, the products owned by the demandee at present are photographed in the office of the attorney of the demandee. The product in the Evidence B is not the one to be transferred. Therefore, Evidence B No. 1 and B No. 5 to B No. 7 do not prove the fact of transfer or delivery from the demandee to Elizabeth or the fact of transfer or delivery from Elizabeth to the others.

### No. 3 The demandee's allegation

The demandee made a reply for requesting that a trial decision that the request for the trial of the case is groundless and the costs in connection with the trial shall be borne by the demandant and mentioned and summarized the reasons in the written reply for the trial case, the oral proceedings statement brief, and the written statement as follows. The demandee submitted Evidence B No. 1 to B No. 23 (including their branch numbers. In a case where the all having branch numbers are cited, the description of branch numbers is omitted below) as means of evidence.

#### 1 Statement of the reply

(1) The product's photos in Respective items of Evidence B No. 1 include photographs of principal surfaces and rear surfaces of three products.

On the principal surface of the product, the characters of "Rubotan", "LINE", "LIQUID", "ルボタン(rubotan)", and "ライン(line)" are written in five lines, and the bold Alphabetic characters of "LINE" are largely written in the second line.

Therefore, the Alphabetic characters of "LINE" and katakana of "ライン(line)" are written in a configuration and a mode in which both characters independently have the distinctiveness, and it can be acknowledged that the use mode is identical to the Trademark from generally accepted perspective.

On the rear surfaces of the three products, the descriptions of "ルボタン ライン(rubotan line)", "distributor Elizabeth Corporation", "contact 03(3262)4061", "manufacturer ISEHAN co., Ltd.", and "7 Gobancho Chiyoda-ku, Tokyo" are written in the upper part in common. The three products are different in that blue numbers of "1", "5", and "7" are largely written on the products in order from the left side, at the center of the labels, "(1) black (eyeliner)", "(5) cocoa (eyeliner)", and "(7) black without gloss (eyeliner)" are written on the products in order from the left, and references of "A33", "A25", and "A37" are written in the lowermost lines on the products in order from the left.

(2) "A copy of sales slip" in Evidence B No. 2 is a copy of the sales slip of Elizabeth.

In a space of "client name", the characters of "MASUDAMASU Morishita logistics center" are written. In the lower line, there is a description of "KK MASUDAMASU yokoyama honten", and in a space of "client address", katakana of "koutouku" is written. In a space of "date", "130313" to "131121" are written. Furthermore, for example, in Evidence B No. 2-1, in the first line of the space of "product code/product name", numbers of "4903362100004", "01", and "529610" are written, and in the second line, "00", "AR600", and "ルボタン ライン(rubotan line)"

are written. In addition, in the third line, numbers of "4903362100042", "07", and "529610" are written, and in the fourth line, "00", "AR600", and "ルボタン ライン (rubotan line)" are written. Each of spaces of "quantity", "delivery quantity", "unit price", and "price" are filled.

According to these, it can be found that Elizabeth has sold the product "ルボタン ライン(rubotan line)" to MASUDAMASU CO.,LTD located in Koto-ku, Tokyo from March 13, 2013 to November 21, 2013. The number "01" in the first line and the number "07" in the third line of the space of "product code/product name" respectively correspond to the number "1" and "7" of the rear surfaces of the products in Evidence B No. 1. This means that the product written in the first line is "black (eyeliner)" and the product written in the third line is "black without gloss (eyeliner)". This is obvious because only the numbers "01", "05", and "07" are included in Evidence B No. 2.

It is obvious that the product of "eyeliner" belongs to "Cosmetics and toiletries" in the designated goods of the Trademark.

(3) Evidence B No. 3 includes copies of the sales slips. It can be found that Elizabeth has sold the product "ルボタン ライン(rubotan line)" to Shinsekai Beniya (Naniwa-ku, Osaka) from March 14, 2013 to November 5, 2013.

(4) "Company profile" in Evidence B No. 4 is the company profile of the demandee. In page nine, "Elizabeth Corporation" is introduced as "introduction of ISEHAN group".

(5) According to Evidences B in (1) to (4), it is obvious that the demandee (manufacturer) and Elizabeth (distributor) which is a group member of the demandee used the Trademark for the product "eyeliner" within three years before the registration of the request for the trial of the case (referred to as "within the period of requiring proof").

## 2 Allegation in the oral proceedings statement brief

### (1) Regarding product's photos in Evidence B No. 1

The product's photos in Evidence B No. 1 were photographed in the office of the attorney of the demandee around December in 2013 when the period of requiring proof has elapsed. However, the demandee does not intend to prove the use of the Trademark only by the product's photos. The demandee intends to prove the use of the Trademark based on the Evidence B No. 1 together with Evidence B No. 2 and B No. 3.

However, since the proving method is not sufficient, the demandee submitted product's photos in Evidence B No. 5 to B No. 7.

Evidence B No. 5 includes photos of the label on the rear surface of the product on the left side in the product's photo photographs from the left and right sides. In the



label on the rear surface, katakana of "ルボタン ライン(rubotan line)" is written in the uppermost part, the characters of "(1) black (eyeliner)" are written in the lower part thereof. The blue number of "1" is written in the center part of the label, and the characters of "A33" are written in the lower part of the label. With these descriptions, the bar code number "4903362100004" is written.

Evidence B No. 6 includes photos of the label on the rear surface of the product at the center in the product's photo photographed from the left and right sides. In the label on the rear surface, katakana of "ルボタン ライン(rubotan line)" is written in the uppermost part, the characters of "(5) cocoa (eyeliner)" are written in the lower part thereof. The blue number of "5" is written in the center part of the label, and the characters of "A25" are written in the lower part of the label. With these descriptions, the bar code number "4903362100028" is written.

In addition, Evidence B No. 7 includes photos of the label on the rear surface of the product on the right side in the product's photo photographed from the left and right sides. In the label on the rear surface, katakana of "ルボタン ライン(rubotan line)" is written in the uppermost part, the characters of "(7) black without gloss (eyeliner)" are written in the lower part thereof. The blue number of "7" is written in the center part of the label, and the characters of "A37" are written in the lower part of the label. With these descriptions, the bar code number "4903362100042" is written.

That is, in the product's photo in Evidence B No. 1, the product on the left is the "eyeliner" of which the color is "black", the product at the center is the "eyeliner" of which the color is "cocoa", and the product on the right is the "eyeliner" of which the color is "black without gloss".

In addition, in the product's photo in Evidence B No. 1, the characters of "A33" and the bar code number of "4903362100004" are written in the label on the rear surface of the product on the left, the characters of "A25" and the bar code number of "4903362100028" are written in the label on the rear surface of the product at the center, and the characters of "A37" and the bar code number of "4903362100042" are written in the label on the rear surface of the product on the right.

Evidence B No. 5 to B No. 7 were photographed by the attorney of the demandee in their office on July 21, 2014.

(2) Regarding manufactured time (time when trademark is affixed) and time of transfer or delivery to Elizabeth of product according to Evidence B No. 1

The demandee proves the manufactured time of the products, that is, the time when the trademark is affixed based on the descriptions of "A33", "A25", and "A37" in

the label on the rear surfaces of the products in the product's photo in Evidence B No. 1.

In Article 5(1) of the "lot number display rule" of the demandee (Evidence B No. 8), the display rule of lot numbers of "general products" is prescribed. Based on the rule, the Alphabetic character "A" on the left side of the label on the rear surface indicates that the number of bulk adjustment is once, the number at the center indicates the lowest digit of the year, and the number at the right end indicates the month. That is, in the product's photo, the lot numbers mean that the bulk adjustment of the product on the left "black eyeliner" was completed and the product was filled in a container with the trademark in March in 2013, the bulk adjustment of the product at the center "cocoa eyeliner" was completed and the product was filled in a container with the trademark in May in 2012, and the bulk adjustment of the product on the right "black eyeliner without gloss" was completed and the product was filled in a container with the trademark in July in 2013.

To prove that the labels on the rear surfaces of the product packaging containers in Evidence B No. 1 were made in 2012 and 2013, not in 2002 or 2003, a copy of a proofread block copy is submitted (Evidence B No. 9). In the copy, there is a description of proofreading date "08.7.4", and "2008.7.4" in handwriting. Therefore, it can be found that the proofreading was applied in 2008.

Therefore, the lot numbers "A33", "A25", and "A37" respectively mean that the bulk adjustment was completed and the product was filled in the container with the trademark in March in 2013, May in 2012, and July in 2013 when the proofreading has been completed.

The demandee submitted the written notification of manufacturing and selling cosmetics in which the product name of "ルボタン ライン(rubotan line)" is applied to the product to Governor of Tokyo on March 26, 2009 (Evidence B No. 10). In the written notification, it was notified that the product is "weighed, mixed, and stored" in "Mitsukaido plant" (Joso-shi, Ibaraki) and the product is "filled, packaged, written, and stored" in "Kawaguchi branch plant" (Kawaguchi-shi, Saitama). That is, the cosmetics having the product name of "ルボタン ライン(rubotan line)" is weighed and mixed in Mitsukaido plant of the demandee located in Joso-shi, Ibaraki, and after that, filled, packaged, and written in Kawaguchi branch plant of the demandee located in Kawaguchi-shi, Saitama.

(3) "Sales slips" in Evidence B No. 2 and B No. 3

In the chart in the "sales slip" in Evidence B No. 2-1, in the descriptions of "4903362100004", "01", and "529610" in the upper space of "product code/product

name" in the column of "1", the number of "4903362100004" is identical to the bar code number in the label on the rear surface of the product on the left in the product's photo in Evidence B No. 1, and the number of "01" is substantially identical to the blue number of "1" at the center of the label on the rear surface. In addition, in the chart of the "sales slip" in Evidence B No. 2-1, in the numbers of "4903362100042", "07", and "529610" in the upper space of "product code/product name" in the column of "2", the number of "4903362100042" is identical to the bar code number in the label on the rear surface of the product on the right in the product's photo in Evidence B No. 1, and the number of "07" is substantially identical to the blue number of "7" at the center of the label on the rear surface. Regarding the number of "529610", from the fifteenth line to the eighteenth line in the "product and stock master" of Elizabeth (Evidence B No. 11), "529610" is written as the "product code", and "01", "05", "06", and "07" are written as the "color". Furthermore, "AR600 ルボタン ライン(rubotan line)" is written as the "product name" of them.

That is, the number of "526910" is the "product code" used by Elizabeth, and the product code means the product of "ルボタン ライン(rubotan line)".

Based on the "product and stock master" of Elizabeth, it can be found that the product having the "product name" of "AR600 ルボタン ライン(rubotan line)" was registered in the "product and stock master" on "January 8, 2008" and the products "eyeliner" having the colors of "01" (black), "05" (cocoa), and "07" (black without gloss) were shipped for the first time on April 9, 2008.

Evidence B No. 12 is "purchase and purchase return monthly reports" from August to October in 2013 by Elizabeth. In the monthly reports, information on products which were purchased by Elizabeth from the demandee was recorded. This report indicates that the purchase by Elizabeth causes the sales of the demandee.

These products are filled, packaged, and written in Kawaguchi branch plant of the demandee, and after that, delivered to Urawa logistics center of the demandee located in TONAMI Transportation Co., Ltd. in Saitama-shi, Saitama (Evidence B No. 13). Subsequently, when a customer orders the product to Elizabeth, which is the distributor, and the product is shipped, the property of the product is transferred from the demandee to Elizabeth at that time, and the demandee gains the sales. The products are sold in this system.

(4) Elizabeth is non-exclusive licensee

A license agreement is permitted to be concluded by implicit manifestation of intention based on the principle of freedom of contract, especially, the principal of

freedom of formalities of contract. Elizabeth is a member of ISEHAN group dominated by the demandee, as indicated in the company profile in Evidence B No. 4.

Therefore, it is obvious that Elizabeth is the non-exclusive licensee of the Trademark based on the implicit license agreement by the demandee.

In addition, in the label on the rear surface of the product in Evidence B No. 1, "Elizabeth Corporation" is written as the "distributor", and "ISEHAN co., Ltd." which is the demandee is written as the "manufacturer".

Therefore, according to the above, it is obvious that the demandee is the manufacturer and Elizabeth, which is the distributor and the related company of the demandee, used the Alphabetic characters of "LINE" deemed identical to the Trademark from generally accepted perspective regarding the product "eyeliner" within the period of requiring proof.

#### (5) Relation with the provisions of Article 2(3) of the Trademark Act

It is obvious that the holder of trademark right which is the demandee affixed the trademark deemed identical to the Trademark from generally accepted perspective on the package of the product "eyeliner" (referred to as "used product" below) in May in 2012, March and July in 2013, transferred or delivered the used product having the package to which the Trademark is affixed to Elizabeth which is the non-exclusive licensee of the Trademark within the period of requiring proof, and Elizabeth which is the non-exclusive licensee of the Trademark transferred or delivered the used product to which the Trademark is affixed to MASUDAMASU and Shinsekai Beniya, which are customers, within the period of requiring proof.

Therefore, such an act falls under Article 2(3)(i) and Article 2(3)(ii) of the Trademark Act.

#### (6) Rebuttal against demandant's allegation

The demandant alleges that since each of "Rubotan/LINE" and "ルボタン/ライン(rubotan/line)" is recognized as a single trademark according to Respective items of Evidence B submitted by the demandee and "LINE" and "ライン(line)" are not independently written, the trademark is not deemed identical from generally accepted perspective.

However, at the center of the front of the package bottle of the product in the product's photo submitted in Evidence B No. 1-1, the bold Alphabetic characters of "LINE" are largely written, and the font of the "LINE" is different from that of the Alphabetic characters of "Rubotan" written in the upper line thereof. Therefore, traders and consumers who see it can recognize and understand the "LINE" as an independent

distinguishing mark. That is deemed identical to the Trademark having the Alphabetic characters of "LINE" and katakana of "ライン(line)" written in two lines from generally accepted perspective.

Furthermore, the demandant insists that a large number of trademarks using the company name are used in the cosmetics industry and each of these trademarks functions as a single distinguishing mark as a whole. However, most of Evidence A after Evidence A No. 2-1 of the demandant are combinations of a word having distinctiveness which is not strong and a trademark composed of a trade name having strong distinctiveness. This is only a method used to easily register these trademarks including the word with distinctiveness which is not so strong. A trademark having component parts which are not inseparably coupled with each other so that it is unnatural to observe component parts of the trademark in a separated state in business dealings is not necessarily pronounced and understood as a whole. Only a part of such a trademark is often simply pronounced and understood, and two or more pronunciations and meanings may be generated from the single trademark. This is understood according to the empirical rules.

Therefore, it is obvious that the trademark using the company name does not necessarily function as a single distinguishing mark as a whole and a component part other than the company name may independently have distinctiveness.

#### (7) Summary

As described above, the demandee proved the use of the trademark deemed identical to the Trademark from generally accepted perspective regarding the product "eyeliner" included in the range of the designated goods related to the demand for trial by the holder of trademark right and non-exclusive licensee in Japan within the period of requiring proof.

#### 3 Allegation in written statement

(1) Evidence B No. 15 is a certificate by the president of Ikeda Printing Co., Ltd. dated on July 25, 2014. This proves that the label on the principal surface of the product in Evidence B No. 1 and the like were delivered to the demandee within the period of requiring proof.

The label on the principal surface of the product in Evidence B No. 1 and the like is displayed and shown in the websites of many dealers and the like (Evidence B No. 16 to B No. 21). For example, the label is used in the product's photo and explanation such that "the liquid eyeliner has been regularly used by many people for a long time." in BIBA SHOP Shimokitazawa (Evidence B No. 19), in a photograph in a

photo in a blog dated on November 19, 2012 which is within the period of requiring proof and the blog describing that ""ルボタンライン(rubotan line)" on the right side is a cosmetic product used to draw eyelines." (Evidence B No. 20), and in a product's photo in OSAKA KATSURAYA "Recommendations" and explanation that "especially, the product No. 7 without gloss has been traditionally used among people in show business." (Evidence B No. 21). According to the above examples, it can be easily presumed and acknowledged that the used product to which the label in Evidence B No. 1 and the like is applied has been manufactured and sold for a long time.

(2) Evidence B No. 22 is a certificate by the president of Elizabeth dated on August 13, 2014 and proves that the "purchase and purchase return monthly report in August, 2013 (copy)", the "purchase and purchase return monthly report in September, 2013 (copy)", and the "purchase and purchase return monthly report in October, 2013 (copy)" attached as Evidence B No. 12-1 to B No. 12-3 were made by Elizabeth.

(3) The address of ISEHAN co., Ltd. written in Evidence B No. 5 to B No. 7 and B No. 9 and B No. 10 is "7 Gobancho Chiyoda-ku, Tokyo". Whereas, the address of ISEHAN co., Ltd. written in Evidence B No. 4 and B No. 13 is "6-11 Yonbancho Chiyoda-ku, Tokyo". These addresses are different because the former is the registered address, and the latter is the actual address of the head office. Evidence B No. 23 is an article regarding the 38th "Essay about three generations goodwill in hundred-year-company" about "ISEHAN co., Ltd." in the website of "KANDA archive" managed by NPO Kanda-Gakkai. An article in the third page "head office moved to Gobancho in 1959, and then, to Yonbancho in 1998 where the current head office is located" and a photograph in the fourth page (head office located in Gobancho holding "KISS ME") are submitted.

That is, ISEHAN co., Ltd. was moved to the current registered address in 1959, and after that, the head office was moved to Yonbancho in 1998. However, the registered address remains in Gobancho.

Therefore, ISEHAN co., Ltd. in Evidences B is the same company.

#### No. 4 Judgment by the body

1 The demandee alleged that the holder of trademark right and non-exclusive licensee have used the trademark deemed identical to the Trademark from generally accepted perspective regarding the product "eyeliner" included in the range of the designated goods "Cosmetics and toiletries" related to the demand for trial in Japan within the period of requiring proof and submitted Evidence B No. 1 to B No. 23. According to

Respective items of Evidence B, the following facts are acknowledged.

(1) Evidence B No. 1 includes the photos of the products. Evidence B No. 1-1 is a photo of three products to which the mark having the characters of "Rubotan", "LINE", "LIQUID", "ルボタン(rubotan)", and "ライン(line)" horizontally written in five lines (referred to as "used trademark" below, refer to the Attachment) is applied. Evidence B No. 1-2 is labels on which the characters of "ルボタン ライン(rubotan line)" and "(eyeliner)" are written and the blue numbers of "1", "5", and "7" are respectively written in order from the left, and "A33", "A25", and "A37" are written in the respective lowermost parts.

(2) Evidence B No. 2 is the copies of the "sales slips" of Elizabeth with the dates from March 13, 2013 to November 21, 2013 in which the "MASUDAMASU Morishita logistics center" is the "client name". In the spaces of the "product code/product name", "4903362100004 01 529610" and "AR600 ルボタン ライン(rubotan line)" (Evidence B No. 2-1, B No. 2-2, B No. 2-4, and B No. 2-5 to B No. 2-12), "4903362100028 05 529610" and "AR600 ルボタン ライン(rubotan line)" (Evidence B No. 2-3, B No. 2-7 to B No. 2-9, and B No. 2-12), and "4903362100042 07 529610" and "AR600 ルボタン ライン(rubotan line)" (Evidence B No. 2-1 to B No. 2-10) are written.

(3) Evidence B No. 3 is the copies of the "sales slips" of Elizabeth with the dates from March 14, 2013 to November 5, 2013 in which "Shinsekai Beniya" is the "client name". In the spaces of the "product code/product name", "4903362100004 01 529610" and "AR600 ルボタン ライン(rubotan line)" (Evidence B No. 3-1 to B No. 3-13), "4903362100028 05 529610" and "AR600 ルボタン ライン(rubotan line)" (Evidence B No. 3-1, B No. 3-2, B No. 3-4 to B No. 3-6, B No. 3-9, B No. 3-12, and B No. 3-13), and "4903362100042 07 529610" and "AR600 ルボタン ライン(rubotan line)" (Evidence B No. 3-1 to B No. 3-13) are written.

(4) Evidence B No. 4 is the copy of the excerpt from the "company profile" of ISEHAN co., Ltd.. In the item of company history, it is described that "1998 New head office building was completed in Yonbancho, Chiyoda-ku, and head office function was moved from Gobancho building" (eighth page), and in the item of "Introduction of ISEHAN group", "ELIZABETH Elizabeth Corporation" is written (ninth page). Furthermore, in the item of "ISEHAN GROUP DATA", "Head office 6-11 Yonbancho Chiyoda-ku, Tokyo", "Business operations manufacture and sales of general cosmetics such as make-up cosmetics, basic cosmetics, and quasi-pharmaceutical products" are written as "ISEHAN co., Ltd.". "Head office 6-11 Yonbancho Chiyoda-ku, Tokyo" and "Phone 03-3262-4061" are written as "Elizabeth Corporation". In addition, on the back

cover, "ISEHAN co., Ltd. 6-11 Yonbancho Chiyoda-ku, Tokyo" is written.

(5) Evidence B No. 5 is the photo of the rear surface of the product on the left in the product's photo in Evidence B No. 1 in which the blue number of "1", "ルボタン ライン(rubotan line)", and "(1) black <eyeliner>" are written. In addition, "Elizabeth Corporation" is written as the "distributor", "03(3262)4061" is written as the "contact", and "ISEHAN co., Ltd. 7 banchi Gobancho Chiyoda-ku, Tokyo" is written as the "manufacturer" (Evidence B No. 5-1), and "4903362100004" is written as the bar code number (Evidence B No. 5-2).

(6) Evidence B No. 6 is the photo of the rear surface of the product at the center in the product's photo in Evidence B No. 1 in which the blue number of "5", "ルボタン ライン(rubotan line)", and "(5) cocoa <eyeliner>" are written. In addition, "Elizabeth Corporation" is written as the "distributor", "03(3262)4061" is written as the "contact", and "ISEHAN co., Ltd. 7 banchi Gobancho Chiyoda-ku, Tokyo" is written as the "manufacturer" (Evidence B No. 6-1), and "4903362100028" is written as the bar code number (Evidence B No. 6-2).

(7) Evidence B No. 7 is the photo of the rear surface of the product on the right in the product's photo in Evidence B No. 1 in which the blue number of "7", "ルボタン ライン(rubotan line)", and "(7) black without gloss <eyeliner>" are written. In addition, "Elizabeth Corporation" is written as the "distributor", "03(3262)4061" is written as the "contact", and "ISEHAN co., Ltd. 7 banchi Gobancho Chiyoda-ku, Tokyo" is written as the "manufacturer" (Evidence B No. 7-1), and "4903362100042" is written as the bar code number (Evidence B No. 7-2).

(8) Evidence B No. 8 is the copy of the document of the title "lot number display rule". According to the allegation by the demandee, "A33", "A25", and "A37" in the lowermost parts on the rear surfaces of the used products indicate the manufactured time, and that has been proved. As the "display method of lot numbers" regarding "Article 5 general products", it is described that "A" in "A57" "indicates the number of bulk adjustments", "5" indicates "the lowest digit of the year, and "7" indicates "the month".

(9) Evidence B No. 9 is assumed as the copy of the "proofread block copy of the label on the rear surface" having the characters of "ISEHAN co., Ltd.". Four labels including three labels on the rear surfaces of the produces in Evidence B No. 5 in which the characters of "ルボタン ライン(rubotan line)" are written in the upper part are displayed. In the lower parts, the description of "2008. 7. 4" is made in handwriting.

(10) Evidence B No. 10 is the copy of the "Written notification of manufacturing and



selling cosmetics" dated on March 26, 2009 which was submitted to Governor of Tokyo by the demandee. In the item of the "product name", "ルボタン ライン(rubotan line)" is written.

(11) Evidence B No. 11 is assumed as the copy of "product and stock master for production and development". In each of the 15th, 16th, and 18th lines in the space of the "product name", "AR600 ルボタン ライン(rubotan line)" is written, and the spaces of the "color", "01", "05", and "07" are written.

(12) Evidence B No. 12 is, according to the demandee's allegation, the copies of the "purchase and purchase return monthly reports" of August in 2013 to October in 2013 in which the information on the product purchased by Elizabeth from the demandee is written. In each Evidence B, "AR600 ルボタン ライン(rubotan line)" is written.

(13) Evidence B No. 15 is the "certificate" dated on July 25, 2014 with the stamp by the president of Ikeda Printing Co., Ltd.. In response to the request by ISEHAN co., Ltd., Ikeda Printing Co., Ltd. created and delivered the labels on the principle surface and the rear surface of the product. It is described in the "certificate" that 10000 labels on the principal surface were delivered in each of March, May, and December in 2013, and 30000 labels were delivered in total. Furthermore, 7000, 2000, and 5000 labels on the rear surface were delivered in March, May, and December in 2013, and 14000 labels were delivered in total. In the photo of the product displayed in the document, although the characters other than "Rubotan" and "LINE" are unclear, the product can be deemed identical to that in Evidence B No. 1-1 from the shape, the color and the like.

(14) Evidence B No. 16 to B No. 21 are the websites introducing the used product. In Evidences B, "ルボタンライン(rubotan line)" is written as the trade name or the product name.

(15) Evidence B No. 23 is the website having the title of "KANDA archive: Essay about three generations goodwill in hundred-year-company" managed by NPO Kanda-Gakkai. Under the headline of "the 38th ISEHAN co., Ltd.", in the third page, it is described that "The head office was moved to Gobancho in 1959, and after that, was moved to Yonbancho where the current office is located.", and "ISEHAN co., Ltd. 6-11 Yonbancho Chiyoda-ku" is written.

2 According to the facts acknowledged in 1 described above, the followings are acknowledged.

(1) On the principal surface of the used product, the trademark (used trademark) in which the characters of "Rubotan", "LINE", "LIQUID", "ルボタン(rubotan)", and "ライン(line)" are written in five lines is written. On the rear surfaces of the used products,

the characters of "ルボタン ライン(rubotan line)", the characters of "(eyeliner)", and "A33", "A25", and "A37" are written in the lowermost parts from the left (1(1) and 1(5) to 1(8)).

In the rear surface of the used product, the name and address of the demandee are written as the manufacturer, and the name and phone number of Elizabeth are written as the distributor. The phone number is the same as that of Elizabeth in the company profile (1(4) to 1(7)).

(2) The products having the bar code numbers of "4903362100004", "4903362100028", and "4903362100042" on the rear surfaces of the used products were sold from Elizabeth to "MASUDAMASU" between March 13, 2013 and November 21, 2013 and to "Shinsekai Beniya" between March 14, 2013 and November 5, 2013 (1(2), 1(3), and 1(5) to 1(7)).

(3) The labels on the principal surface and the rear surface of the used product were delivered from Ikeda Printing Co., Ltd. to the demandee in March, May, and December in 2013 (1(13)).

### 3 Judgment

#### (1) Regarding product which is used

The used product of the Trademark is the "eyeliner" and belongs to the range of "Cosmetics and toiletries" in the designated goods related to the demand for trial of the case.

#### (2) Regarding licensee and time of use

A According to 2(1) described above, the labels on the principal surface and the rear surface of the used product were delivered to the demandee in March, May, and December in 2013, and the name and the address of the demandee were written on the label on the rear surface as the manufacturer. Since it is acknowledged that the used product to which the label is applied was manufactured in March, May, and December in 2013, it can be said that the demandee applied the used trademark to the package of the used product at that time.

B According to 2(1) described above, Elizabeth is a company belonging to ISEHAN group dominated by the demandee, and the name and the phone number of Elizabeth are written on the rear surface of the used product as the distributor. Since the phone number is the same as that of Elizabeth in the company profile, it can be said that Elizabeth which is the distributor of the used product is the same as Elizabeth belonging to ISEHAN group.

In consideration of that Elizabeth is written as the distributor together with the

description of the demandee which is the manufacturer on the rear surface of the used product, it can be said that the implicit license agreement was concluded between Elizabeth and the demandee regarding the use of the Trademark by Elizabeth. Elizabeth can be acknowledged as the non-exclusive licensee of the Trademark.

In addition, it is acknowledged that Elizabeth transferred or delivered the used product in which the used trademark is applied to the package to "MASUDAMASU" and "Shinsekai Beniya" in a period from March 14, 2013 to November 21, 2013. The above period is within the period of requiring proof.

### (3) The Trademark and used trademark

#### A Regarding the Trademark in the Application

As described in No. 1, the Trademark consists of the Alphabetic characters of "Line" and katakana of "ライン(line)" horizontally written in two lines. In the configuration, since the character part of "ライン(line)" in the lower line is recognized as phonetic characters of the Alphabetic character of "Line" in the upper line, this gives rise to the pronunciation of "rain". The Alphabetic characters of "Line" form a simple English word having the meaning of "line and series". Therefore, the Alphabetic characters of "Line" give rise to the meaning of "line and series".

#### B Regarding used trademark

As in the Attachment, in the used trademark, the Alphabetic characters of "Rubotan" are largely written in the uppermost line, and the Alphabetic characters of "LINE" which are slightly larger than the characters of "Rubotan" are arranged under them. Under the characters of "LINE", the Alphabetic characters of "LIQUID" are written. "LIQUID" and katakana of "ルボタン(rubotan)" and "ライン(line)" are written in three lines with the size smaller than those in the upper two lines.

The character part of "LIQUID" in the configuration is written with characters which are extremely smaller than and written in the different font as those of the Alphabetic characters in the upper two lines. The character part of "LIQUID" is recognized as a word indicating that the product is "liquid". Therefore, the word "LIQUID" itself does not have a function for distinguishing relevant products from others. Accordingly, the part other than the character part of "LIQUID" functions as a distinguishing mark for distinguishing relevant products from others in the used trademark. In the configuration of the used trademark, although the Alphabetic character parts of "Rubotan" and "LINE" in the upper two lines are different from each other in font and size, both fonts are normally used fonts, and katakana which can be recognized as the phonetic characters of "Rubotan" and "LINE" is collectively written

in the same font and size in the lower two lines. In addition, the pronunciation of "rubotanrain" resulting from the overall configuration of the character part can be pronounced smoothly in series. In consideration of the above, the Alphabetic character parts of "Rubotan" and "LINE" in the upper two lines and katakana parts of "ルボタン (rubotan)" and "ライン(line)" in the lower two lines can be the main part to distinguish relevant products from others. In addition, it can be said that those character parts form a coined word which do not evoke a specific meaning as a whole.

Therefore, it can be said that the trademark which functions as the distinguishing mark of the used trademark gives rise to the pronunciation of "rubotanrain" and is a coined word which do not evoke a specific and familiar meaning.

#### C Similarity between the Trademark and used trademark

As described in A, the Trademark consists of the Alphabetic characters of "Line" and katakana of "ライン(line)" horizontally written in two lines, and gives rise to the pronunciation of "rain" and the meaning of "line and series".

As described in B, in the used trademark, the Alphabetic character parts of "Rubotan" and "LINE" and katakana of "ルボタン(rubotan)" and "ライン(line)" function as the distinguishing mark. These characters give rise to the pronunciation of "rubotanrain" and do not give rise to a specific meaning.

Therefore, in comparison of the Trademark and the used trademark, both trademarks have characters which are obviously different from each other, and the pronunciations and appearances of both trademarks are not the same.

Therefore, the used trademark cannot be deemed identical to the Trademark from generally accepted perspective.

#### B Other Evidence B

In the other respective items of Evidence B submitted by the demandee such as the photos of the rear surfaces of the products, transaction documents including the sales slips, the written notification of manufacturing and selling cosmetics, and the websites introducing the used product, the fact such that the characters of "ルボタン ライン (rubotan line)" or "ルボタンライン(rubotan line)" were used can be confirmed. However, any evidences to prove the use of the trademark identical to the Trademark from generally accepted perspective cannot be found.

#### (4) Summary

According to (1) to (3) described above, it can be acknowledged that the demandee (holder of trademark right) and the non-exclusive licensee used the used trademark for the "eyeliner" belonging to the range of "Cosmetics and toiletries" in the

designated goods of the Trademark related to the demand for trial within the period of requiring proof. However, the used trademark is not deemed identical to the Trademark from generally accepted perspective, and it cannot be said that the use of the trademark identical to the Trademark from generally accepted perspective has been proved.

#### 4 Closing

As described above, according to Respective items of Evidence B submitted by the demandee, it should be said that the demandee does not prove that any one of the holder of trademark right, its exclusive licensee, or non-exclusive licensee used the Trademark (including identical one from generally accepted perspective) for any one of the designated goods related to the demand for trial in Japan within three years before the registration of the request for the trial of the case, and in addition, the demandee does not mention justifiable reasons for non-use.

Accordingly, the registration of the Trademark should be invalidated in accordance with Article 50(1) of the Trademark Act.

Therefore, the trial decision shall be made as described in the conclusion.

August 21, 2015

Chief administrative judge: HAYASHI, Eiji  
Administrative judge: KAJIWARA, Yoshiko  
Administrative judge: NAKATSUKA, Toshie

[Attachment (Used trademark)]

